

**REMARKS**

Applicants respectfully request reconsideration of the rejections in view of this Amendment. Claims 1-20 are currently pending in connection with the present application. Claims 6-20 have been added by the present response. Claims 1, 3, and 12 are the independent claims.

**Priority Documents**

Applicants recognize the Examiner's acknowledgment of Applicants' claim for priority under 35 U.S.C. §119, and the indication of the receipt of all of the necessary priority documents as indicated in the Office Action Summary dated April 29, 2005.

**Information Disclosure Statement**

Applicants acknowledge and thank the Examiner for the consideration of the references cited in the Information Disclosure Statement filed on February 26, 2004, as indicated by the Examiner's initials and signature on the PTO-1449 form.

**Prior Art Rejections under 35 U.S.C. §103(a)**

**Claims 1-5** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakagawa (U.S. Patent No. 6,611,663 B2) in view of Ihara (U.S. Patent No. 5,886,832). Applicants respectfully traverse this rejection.

**Claim 1**

With regard to **claim 1**, the Examiner recognizes on page 2 of the Office Action that Nakagawa fails to teach or suggest at least "one helicoidal screw formed on an elastic piece

formed by slitting one portion of the barrel body, and said elastic piece being thrust against the other helicoidal screw by a biasing force of said elastic piece”, as set forth in claim 1 for example. Nakagawa teaches only two helical screw portions. The Examiner relies on the teachings of Ihara for allegedly making up for this deficiency. However, Applicants respectfully disagree with the Examiner’s conclusion that Ihara teaches the limitation, and thus disagree with the conclusion that the alleged combination of Nakagawa and Ihara, even assuming *arguendo* that they could be combined, meets the aforementioned limitation of claim 1.

As shown in Fig. 1 and column 1, lines 59-65, Ihara teaches a lens holding frame main member **10**, a truncated cone-shaped cam follower **12** formed partially with a cut or cut-out portion **11**, and an elastic member **20** disposed in the cut portion **11**.

Ihara’s lens barrel does not teach, and in fact has nothing to do with a helicoidal screw formed on an elastic piece formed by slitting one portion of the barrel body, as set forth in claim 1 for example. Ihara’s elastic member **20** is disposed in the cut portion **11**, **and is not disclosed to have one helicoidal screw formed thereon, as claimed in claim 1, for example.** Also, the cut portion **11** of Ihara is cut from the truncated cone-shaped cam follower **12**, and not the lens holding frame main member **10** or the lens holding frame **100**. **Therefore, the elastic member 20 is not and cannot be “formed by slitting one portion of the barrel body”, as claimed in claim 1, for example.** Subsequently, it is clear from the above that Ihara does not disclose at least one helicoidal screw formed on an elastic piece formed by slitting one portion of the barrel body, as set forth in claim 1, for example.

Further, as claimed in claim 1, not only is such an elastic piece formed by slitting a portion of the barrel body, but the elastic piece is also one which is **thrust against the**

**other helicoidal screw by a biasing force of said elastic piece.** Such a slit-formed elastic piece with such a biasing force is distinct from Ihara, as well as Nakagawa. The slit-formed structure of the elastic piece is one which can be biased to encourage coupling with the helicoidal screw. No such biased element is taught or suggested in Ihara, only a cut portion **11** cut from the truncated cone-shaped cam follower **12**, and an elastic member **20** disposed in the cut portion **11**.

Accordingly, since neither Nakagawa nor Ihara disclose at least “one helicoidal screw is formed on an elastic piece formed by slitting one portion of the barrel body and said elastic piece being thrust against the other helicoidal screw by a biasing force of said elastic piece”, as set forth in claim 1 for example. Applicants respectfully submit that neither Nakagawa nor Ihara, nor a combination of the two, teaches or suggests all of the limitations as set forth in claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

### **Claim 3**

With regard to independent **claim 3**, while this claim should be governed solely by the limitations present therein, Applicants respectfully submit that claim 3 is also allowable at least for reasons somewhat similar to those set forth with regard to claim 1. For example, the alleged combination of prior art references (even assuming *arguendo* that they could be combined) fails to teach or suggest at least “the helicoidal screw formed on one barrel body is formed on an elastic piece formed by slitting one portion of said one barrel body..., and said elastic piece is thrust, by a biasing force of said elastic piece, against the helicoidal screw”, as set forth in claim 3. Accordingly, withdrawal of the rejection is requested.

With regard to the remaining dependent claims, Applicants respectfully submit that these claims are allowable for at least the reasons set forth regarding their respective independent claims.

### **Motivation Lacking**

Applicants further submit that the Examiner has not supplied the necessary motivation nor **evidence** of the necessary motivation needed to lead one of ordinary skill in the art to combine the teachings of Nakagawa and Ihara. Accordingly, absent such motivation, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection of claim 1 must be withdrawn.

Applicants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicants. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999).

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. **Broad conclusory statements standing alone are not "evidence".**

The Examiner has not provided a motivation for combining the teachings of Nakagawa and Ihara. Nakagawa teaches only two coupleable helicoidal screw portions, and thus is clearly lacking claim limitations. Ihara is a completely different structure, and has nothing to do with helicoidal screws or coupleable screw portions. Instead of addressing these vast differences, the Examiner has chosen to ignore them. Thus, **the Examiner has failed to assert any motivation for the combination** that is present in any of the references, in the knowledge of one of ordinary skill in the art, or in the nature of the problem to be solved. In essence, the Examiner has reviewed the present application, selected a prior art structure containing a lens barrel with inner and outer barrel body helicoidal screws, and then searched other prior art for the missing elements (without success as identified above) **without identifying or discussing any specific evidence of motivation to combine.**

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. Dembiczak, 50 USPQ2d at 1617. Accordingly, Applicants respectfully submit that the claims are allowable for at least this additional reason.

Furthermore, the Examiner has not provided the **requisite evidence** to support his allegation that there is motivation to combine Nakagawa and Ihara, so as to render obvious that which Applicants have described. The Examiner has not provided any showing of a

suggestion, teaching or motivation to combine the prior art references to reject the claims in the present application, which is an essential component of an obviousness holding. The Examiner must explain the *reasons why* one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious (In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) the examiner can satisfy the burden of showing obviousness of the combination "only by showing *some objective teaching in the prior art or that knowledge generally available* to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). Thus, the Examiner has not adequately provided a proper combination of Nakagawa and Ihara to render claim 1 obvious.

Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). Further, relying on obvious design choice as a reason for combining teachings of the various references is again not the proper standard for obviousness. *If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration* setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly, Applicants respectfully challenge the Examiner's alleged motivation and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained.

In view of the above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103(a).

### **New Claims**

With regard to the new claims presented in this communication, Applicants respectfully request allowance of new claims 6-20. With regard to independent claim 12, although this claim should be governed solely by the limitations presented therein, this claim is also allowable at least for reasons somewhat similar to those set forth above with regard to claim 1. For example, the alleged combination of prior art references (even assuming *arguendo* that they could be combined) fails to teach or suggest at least “at least a portion of one of the screw structures, formed on an elastic tab structure integrally formed from a portion of at least one of the inner and outer barrel body, being thrust against part of the other screw structure via a biasing force”. With regard to the remaining dependent claims, Applicants respectfully submit that these claims are allowable for at least the reasons set forth regarding their respective independent claims.

### **CONCLUSION**

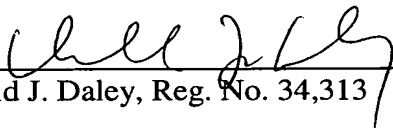
In view of the amendments and remarks, reconsideration of all outstanding objections and rejections and allowance of each of claims 1-20 in connection with the present application is earnestly solicited.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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